

STATUS OF CLAIMS AND SUPPORT FOR CLAIM CHANGES
(37 C.F.R. §1.173(c))

1. The status of the claims as a result of the amendment submitted herewith is:

Claims 1-3, 5-10, 12, 13, 15, 16, and 78-103 are pending.

2. The support in the disclosure of the patent for the claims new claims as presented herein are as follows:

Claims Claims 78-90, and claims 91-103 have been added and each are copies of claims 1-3, 5-10, 12, 13, 15, 16 except that claims independent claims 78 and 91 include additional matter for clarity which is supported by Col. 1, lines 53-55; col. 2, line 59 to col. 4, line 2; and col. 4, lines 40-48.

R E M A R K S

To avoid confusion, the history of recent prosecution is presented. An Advisory Action was mailed 9/27/06 which indicated that the amendment filed 9/6/06, in which only claim 1 was amended, would not be entered but would be entered on appeal. A draft supplemental amendment after final was submitted to the Examiner by fax on 10/2/06, based on an interview the same day. On 10/3/04, a supplemental amendment after final was filed by private PAIR based on an interview with the Examiner the same day. During an interview on 10/4/06, the Examiner indicated the amendment filed 10/3/06 would not place the application in condition for allowance.

The Examiner agreed to not enter the amendment filed 10/3/06 in order to enter, at least for the purpose of appeal, an amendment to be filed on 10/4/06 to include the claims as amended in the 9/6/06 amendment after final, as well as an identical set of claims based on the amendment to claim 1 submitted by fax on 10/2/06 and a third identical set of claims based on the amendment to claim 1 in the amendment filed 10/3/06.

New independent claim 78 presented herewith is a copy of claim 1 as amended in the draft sent 10/2/06 and new independent claim 91 is a copy of claim 1 as amended in the supplemental amendment filed 10/3/06. The new claims dependent on claim 78 and on claim 91 are copies of the claims dependent on claim 1 as amended.

1. Status of claims:

Claims 4, 11, 14, 17, 18 and 77 have been canceled. Claims 1-3, 5-10, 12, 13, 15, 16 and 78-103 are pending.

2. Request for withdrawal of Finality as premature:

Applicant respectfully repeat his requests that if this application is not allowed, the finality of the current Office Action be withdrawn as premature because the grounds of rejection are new.

In particular, the rejection in the FINAL office action, that claim limitations related to the identification code are considered non functional descriptive material, was first made in this FINAL office action and was not caused by amendments made by the applicant. In fact, the FINAL rejection was based on claim 1 as originally issued which included this claim language.

Further, as noted below, the anticipation rejection of claim 1 is not a prima facie rejection under 35 U.S.C. 102(e) because Freeny does not teach the use of the identification code as claimed (and the Examiner's statement that such identification code as claimed is considered non function descriptive language does not apply to the anticipation rejection as presented by the Examiner). New independent claims 78 and 91 are expanded versions of claim 1 presented to clarify the identification code claim language is not non-functional descriptive language.

Further, as noted below, the obviousness rejection is not a prima facie rejection under 35 U.S.C. 103(a) because even if Freeny were modified so that identification code as claimed were input to control unit 34, Freeny does not teach that data input to control unit 34 is applied to the software carrier as claimed in claim 1. Control unit 34 acts as a gate keeper to authorize data held elsewhere to be applied to the software carrier to assure that such data is only applied when appropriate royalty payments are made.

If the finality of this rejection is not withdrawn, Applicants will not have had the opportunity to counter these rejections as a matter of right.

3. Request for entry of amendment under 35 CFR 1.116:

In the alternative, Applicants respectfully request that this amendment be entered under 37 CFR 1.116(b) 1 and 3 for the following reasons:

- (1) rejected claims 11, 14, 17, 18 and 77 are canceled;
- (3) this amendment is necessary because the rejections presented in the Final Action are new and Applicants have not yet had the opportunity to counter these rejections.

4. Applicant's responses to the rejections

Claims 1-10, 12, 13, 15 and 16 stand rejected under 35 U.S.C. 102(e) as anticipated by Freeny. Claim 1 has been amended and claim 4 has been canceled.

Applicants traverse this rejection as not being a prima facie 102(e) rejection in that Freeny does not teach the claimed elements. Although in par. 11 of the FINAL Action, the Examiner has stated that in the rejection of claim 1 under 35 U.S.C. 103(a) as obvious over Freeny, claim limitations related to the identification code are considered non functional descriptive material, this basis for rejection was not stated by the Examiner to apply to the anticipation rejection.

The embedding of purchaser identification, point of sale identification or date of purchase cannot be anticipated by Freeny which does not teach the embedding of such identification codes but rather teaches only embedding "owner codes, catalog reproduce codes or catalog transmit codes" as noted by the Examiner at the top of page 3 of the final rejection.

5. Continuing traverses

Applicant respectfully continues his traverse to statements in the FINAL action that Freeny discloses:

a) memory within digital storage unit 86 in POS 14 which anticipates the claim element "a memory for storing software for distribution to customers" as claimed in claim 1;

b) means for embedding an identification code in the software within reproduction unit 24 which anticipates the claim element "means for embedding said identification code on the software carrier" as claimed in claim 1; and

c) means for preventing copying which anticipates the claim element "means for preventing copying of software copied onto the software carrier" as claimed in claim 4 in that Freeny can be said to teach the use of "owner codes, decipher program, to prevent copying information onto the software carrier rather than preventing copying of software already on the software carrier.

6. Applicants' response to the obviousness rejection:

Claims 1-10, 12, 13, 15 and 16 stand rejected under 35 U.S.C. 103(a), as obvious over by Freeny. Claim 1 has been amended and claim 4 has been canceled.

The Examiner has rejected these claims stating that it would have been obvious to modify Freeny to input purchaser identification, such as credit authorization, into manufacturing control unit 34 because Freeny allows the inputting of "other various data" into control unit 34 based on his position.

Applicants continue to traverse this rejection as not being a prima facie §103(a) rejection because control unit 34 does not reproduce the received information in a software carrier, but rather provides the authorization select code on line 50 to manufacturing unit 36 which permits unit 36 to decode the encoded information provided thereto by file unit 32 on line 48 so that it can be applied by reproduction unit 24 for application to the software carrier.

Applicant respectfully continues his traverse of the Examiner's statement that the identification code language is non functional descriptive language. The Examiner noted that MPEP 2106 IV B 1b, was relied on for this rejection. This section makes it clear that nonfunctional descriptive material is descriptive material that cannot exhibit any functional relationship with the way in which computing processes are performed. In particular, descriptive material such as music does not impart functionality to data so structured.

The claim language at issue, the nature of the identification code, provides the apparatus as claimed with a function not otherwise available. The claimed automated merchandising system dispenses software on a software carrier which can be distinguished from all other copies of that software on a software carrier by the identification code associated with the software and embedded on the software carrier. The claimed automated merchandising system therefore can dispense software on carriers with less likelihood of such software being unlawfully. The associating and embedding of identification code related to the purchase distinguishes lawfully purchased software used by the purchaser from unlawful copies made therefrom and used by others.

The functional relationship between the associated and embedded code and the software provided to the customer by the automated merchandizing system is clear as claimed. A further set of claims, beginning with claim 78, has been provided which is a copy of claim 1 and its dependent claims except that the function of preventing copying of software, copied onto the software carrier, by recording the embedded identification code together with program identification code comprising at least one of the following program identification parameters: program identification and a serial number for the program copy is specifically claimed. A further set of claims, beginning with claim 78, has been provided which is a copy of claim 1 and its dependent claims except that the

functionality of the identification code preventing copying by
identifying the selected software provided to the customer on the
software carrier is set specifically claimed.

Applicant respectfully requests that the rejection of the claims be reconsidered in light of the amendments made herein and this case be passed to issue. If not passed to issue, applicant respectfully requests that the finality of this action be withdrawn because the rejections are not prima facie rejections. If the finality is not withdrawn, applicant respectfully requests that this supplemental amendment after FINAL be entered to reduce issues on Appeal and at the pre-Appeal brief conference.

Respectfully Submitted,

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